REMARKS

Claims 1-3, 12-14 and 26-27 have been amended. Claims 18, 19, 25 and 28 have been canceled. No new claims have been added. Claims 1-17, 20-24, 26-27 and 29-37 remain pending in the application.

Applicant thanks the Examiner for indicating that claims 11, 24 and 32-37 are allowable over the prior art of record.

Support for Amendments

Claims

Support for the amendments to claims 1, 12 and 26 pertaining to "a deck with a planar upper surface" can be found in the specification at paragraph [0051].

Support for the amendments to claim 26 pertaining to positioning of the hitch attachments "below the planar upper surface" can be found in the specification at paragraph [0063] and FIGs 1-4.

Objections/Rejections
Under 35 U.S.C. §102

1.0 *The examiner has rejected claims 1 and 8-10 as anticipated by Wassell (United States Patent 3,839,979).*

SUMMARY OF CITED REFERENCE

Wassell discloses a collapsible wind propelled vehicle. The relevant embodiment of the vehicle, represented by FIG 16, includes a central pontoon [20'], nominally referenced as a hull, with a first pontoon [10s] attached proximate the starboard side of the central pontoon [20'] and a

second pontoon [10p] attached proximate the port side of the central pontoon [20']. The first and second pontoons [10s and 10p] are repositionably attached to the central pontoon [20'] for lateral and longitudinal repositioning of the first and second pontoons [10s and 10p] as between a storage position in which the first and second pontoons [10s and 10p] are generally longitudinally aligned relative to the central pontoon [20'] and have a minimized lateral distance between the pontoons [10s and 10p], and a use position in which the first and second pontoons [10s and 10p] are shifted fore relative to the longitudinally aligned storage position and have a maximized lateral distance between the pontoons [10s and 10p]. Wassell discloses that the collapsible frame may support a deck, but is silent as to the nature of that deck (*e.g.*, rigid metal or flexible canvas) and is silent as to the location and/or means of attaching the decking onto the collapsible frame.

SUMMARY OF CLAIMED INVENTION

A First Embodiment of the present claimed invention (claims 1-11) is directed to personal watercraft having (i) a hull defining a deck with a planar upper surface, and (ii) a plurality of pontoons repositionably attached to the hull with at least one pontoon attached proximate the starboard side of the hull and at least one pontoon attached proximate the port side of the hull. The pontoons are laterally and longitudinally repositionable as between a storage position in which the pontoons are generally longitudinally aligned relative to the hull and have a minimized lateral distance between the pontoons, and a flotation position in which the pontoons are shifted aft relative to the longitudinally aligned storage position and have a maximized lateral distance between the pontoons.

LEGAL BASIS

An anticipation rejection under 35 U.S.C. § 102 requires that the cited reference(s) disclose each and every element of the claimed invention. *See,* Hybritech Inc. v. Monoclonal Antibodies, Inc., 231 U.S.P.Q. 81, 90 (Fed. Cir. 1986); Kloster Speedsteel AB et al. v. Crucible Inc. et al., 230 U.S.P.Q. 81, 84 (Fed.Cir. 1986). A reference anticipates a claim only when the reference discloses each and every element recited in the claim. See, Verdegaal Bros. v. Union Oil Co. of California, 2 U.S.P.Q.2d 1051 (Fed. Cir. 1987) and M.P.E.P. §2131. Accordingly, the "exclusion of a claimed element from a prior art reference is enough to negate anticipation by

that reference." Atlas Powder Co. v. E.I. duPont De Nemours & Co., 224 U.S.P.Q. 409, 411 (Fed. Cir. 1984).

WASSER DOES NOT DISCLOSE EACH AND
EVERY ELEMENT OF THE CLAIMED INVENTION

Wasser discloses a collapsible wind propelled vehicle wherein side pontoons can be shifted outward and ***forward*** from a longitudinally aligned storage position. In contrast, the First Embodiment of the Present Claimed Invention is directed to personal watercraft wherein side pontoons can be shifted outward and ***rearward*** from a longitudinally aligned storage position. Applicant has discovered that such rearward repositioning is essential to achieving proper flotation stability.

Wasser discloses use of the collapsible frame to support a deck, but does not disclose, teach or suggest the nature of that deck (*e.g.*, rigid metal or flexible canvas) and is silent as to the location and/or means of attaching the decking onto the collapsible frame. The extremely modest size of the central pontoon, or complete lack thereof in most embodiments, combined with the collapsible nature of the entire frame, suggests that the deck would be a flexible canvas-type decking. In contrast, the First Embodiment of the Present Claimed Invention is directed to personal watercraft with a deck providing a planar upper surface. Applicant has discovered that a planar upper decking is essential for certain desired application of the watercraft, such as fishing.

2.0 *The examiner has rejected claims 12, 18, 19, 22 and 23 as anticipated by Rypinski (United States Patent 5,582,126).*

SUMMARY OF CITED REFERENCE

Rypinski discloses a modular watercraft system. The relevant embodiment of the system, represented by FIG 4, includes a central hull [14] with a first pontoon [18] attached proximate the starboard side of the central hull [14] and a second pontoon [18] attached proximate the port side of the central hull [14]. The first and second pontoons [18] are

repositionably attached to the central hull [14] for lateral and longitudinal repositioning of the first and second pontoons [18] as between a storage position in which the first and second pontoons [18] are generally longitudinally positioned proximate the stern of the central hull [14] with a minimized lateral distance between the pontoons [18], and a use position in which the first and second pontoons [18] are shifted fore relative to the storage position and have a maximized lateral distance between the pontoons [18].

SUMMARY OF CLAIMED INVENTION

A Second Embodiment of the present claimed invention (claims 12-24) is directed to personal watercraft having (i) a hull defining a deck with a planar upper surface, and (ii) a plurality of pontoons repositionably attached to the hull with at least one pontoon positioned off a starboard bow of the hull, at least one pontoon positioned off a starboard quarter of the hull, at least one pontoon positioned off a port bow of the hull, and at least one pontoon positioned off a port quarter of the hull. The pontoons are laterally and longitudinally repositionable as between a storage position having a minimized lateral and longitudinal distance between the pontoons to facilitate transportation and storage, and a flotation position having a maximized lateral and longitudinal distance between the pontoons to provide improved flotation stability relative to the storage position.

LEGAL BASIS

An anticipation rejection under 35 U.S.C. § 102 requires that the cited reference(s) disclose each and every element of the claimed invention. *See,* Hybritech Inc. v. Monoclonal Antibodies, Inc., 231 U.S.P.Q. 81, 90 (Fed. Cir. 1986); Kloster Speedsteel AB et al. v. Crucible Inc. et al., 230 U.S.P.Q. 81, 84 (Fed.Cir. 1986). A reference anticipates a claim only when the reference discloses each and every element recited in the claim. See, Verdegaal Bros. v. Union Oil Co. of California, 2 U.S.P.Q.2d 1051 (Fed. Cir. 1987) and M.P.E.P. §2131. Accordingly, the "exclusion of a claimed element from a prior art reference is enough to negate anticipation by that reference." Atlas Powder Co. v. E.I. duPont De Nemours & Co., 224 U.S.P.Q. 409, 411 (Fed. Cir. 1984).

RYPINSKI DOES NOT DISCLOSE EACH AND
EVERY ELEMENT OF THE CLAIMED INVENTION

Rypinski discloses a modular watercraft system with a ***pair*** of repositionable side pontoons. In contrast, the Second Embodiment of the Present Claimed Invention is directed to personal watercraft with at least ***four*** repositionable side pontoons. Applicant has discovered that the use of four repositionable side pontoons, as opposed to just two, enhances the ability to adjust flotation stability to accommodate different situations.

3.0 *The examiner has rejected claims 25 and 28 as anticipated by Rudder (United States Patent 3,902,741).*

Claims 25 and 28 have been cancelled.

4.0 *The examiner has rejected claim 26 as anticipated by Vanderlinde (United States Patent 5,547,209).*

SUMMARY OF CITED REFERENCE

Vanderlinde discloses a boat transport device which includes a pair of C-clamps [31] each bearing a journal bracket [30] for releasable attachment to a boat [10] along the uppermost edge of the stern. The device permits a boat [10] to be towed in an inverted position.

SUMMARY OF CLAIMED INVENTION

A Third Embodiment of the Present Claimed Invention (claims 26, 27 and 29-37) is directed to a personal watercraft having (i) a hull defining a deck with a planar upper surface, and (ii) a pair of laterally spaced hitch attachments secured to the hull below the planar upper surface and proximate the stern.

LEGAL BASIS

An anticipation rejection under 35 U.S.C. § 102 requires that the cited reference(s) disclose each and every element of the claimed invention. *See,* Hybritech Inc. v. Monoclonal Antibodies, Inc., 231 U.S.P.Q. 81, 90 (Fed. Cir. 1986); Kloster Speedsteel AB et al. v. Crucible Inc. et al., 230 U.S.P.Q. 81, 84 (Fed.Cir. 1986). A reference anticipates a claim only when the reference discloses each and every element recited in the claim. See, Verdegaal Bros. v. Union Oil Co. of California, 2 U.S.P.Q.2d 1051 (Fed. Cir. 1987) and M.P.E.P. §2131. Accordingly, the "exclusion of a claimed element from a prior art reference is enough to negate anticipation by that reference." Atlas Powder Co. v. E.I. duPont De Nemours & Co., 224 U.S.P.Q. 409, 411 (Fed. Cir. 1984).

VANDERLINDE DOES NOT DISCLOSE EACH AND EVERY ELEMENT OF THE CLAIMED INVENTION

Vanderlinde discloses a boat transport device which includes a pair of C-clamps for releasable attachment to a boat ***along the uppermost edge of the stern***. In contrast, the Third Embodiment of the Present Claimed Invention is directed to personal watercraft having a hull defining a deck with a planar upper surface, and a pair of laterally spaced hitch attachments ***secured to the hull below the planar upper surface***. Applicant has discovered that such positioning of the hitch attachments allows the hitch attachment to remain attached to the watercraft during use without hindering normal use of the watercraft, and permits the watercraft to be towed in the normal upright position.

Objections/Rejections
Under 35 U.S.C. § 103

5.0 *The examiner has rejected claims 2-6 as obvious over Wassell (United States Patent 3,839,979).*

SUMMARY OF CITED REFERENCE

Wassell discloses a collapsible wind propelled vehicle. The relevant embodiment of the vehicle, represented by FIG 16, includes a central pontoon [20'], nominally referenced as a hull, with a first pontoon [10s] attached proximate the starboard side of the central pontoon [20'] and a second pontoon [10p] attached proximate the port side of the central pontoon [20']. The first and second pontoons [10s and 10p] are repositionably attached to the central pontoon [20'] for lateral and longitudinal repositioning of the first and second pontoons [10s and 10p] as between a storage position in which the first and second pontoons [10s and 10p] are generally longitudinally aligned relative to the central pontoon [20'] and have a minimized lateral distance between the pontoons [10s and 10p], and a use position in which the first and second pontoons [10s and 10p] are shifted fore relative to the longitudinally aligned storage position and have a maximized lateral distance between the pontoons [10s and 10p]. Wassell discloses that the collapsible frame may support a deck, but is silent as to the nature of that deck (*e.g.*, rigid metal or flexible canvas) and is silent as to the location and/or means of attaching the decking onto the collapsible frame.

SUMMARY OF CLAIMED INVENTION

A First Embodiment of the present claimed invention (claims 1-11) is directed to personal watercraft having (i) a hull defining a deck with a planar upper surface, and (ii) a plurality of pontoons repositionably attached to the hull with at least one pontoon attached proximate the starboard side of the hull and at least one pontoon attached proximate the port side of the hull. The pontoons are laterally and longitudinally repositionable as between a storage position in which the pontoons are generally longitudinally aligned relative to the hull and have a minimized lateral distance between the pontoons, and a flotation position in which the pontoons are shifted aft relative to the longitudinally aligned storage position and have a maximized lateral distance between the pontoons.

LEGAL BASIS

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found in the prior art, NOT in applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). *See,* M.P.E.P. § 2143.

WASSER DOES NOT TEACH OR SUGGEST
ALL OF THE CLAIM LIMITATIONS
OF THE CLAIMED INVENTION

Wasser discloses a collapsible wind propelled vehicle wherein side pontoons can be shifted outward and ***forward*** from a longitudinally aligned storage position. In contrast, the First Embodiment of the Present Claimed Invention is directed to personal watercraft wherein side pontoons can be shifted outward and ***rearward*** from a longitudinally aligned storage position. Wasser does not disclose, teach or suggest such rearward repositioning. Applicant has discovered that such rearward repositioning is essential to achieving proper flotation stability.

In addition, Wasser discloses use of the collapsible frame to support a deck, but does not disclose, teach or suggest the nature of that deck (*e.g.*, rigid metal or flexible canvas) and is silent as to the location and/or means of attaching the decking onto the collapsible frame. The extremely modest size of the central pontoon, or complete lack thereof in most embodiments, combined with the collapsible nature of the entire frame, suggests that the deck would be a flexible canvas-type decking. In contrast, the First Embodiment of the Present Claimed Invention is directed to personal watercraft with a deck providing a planar upper surface. Applicant has discovered that a planar upper decking is essential for certain desired application of the watercraft, such as fishing.

6.0 The examiner has rejected claims 13-17 as obvious over Rypinski (United States Patent 5,582,126).

SUMMARY OF CITED REFERENCE

Rypinski discloses a modular watercraft system. The relevant embodiment of the system, represented by FIG 4, includes a central hull [14] with a first pontoon [18] attached proximate the starboard side of the central hull [14] and a second pontoon [18] attached proximate the port side of the central hull [14]. The first and second pontoons [18] are repositionably attached to the central hull [14] for lateral and longitudinal repositioning of the first and second pontoons [18] as between a storage position in which the first and second pontoons [18] are generally longitudinally positioned proximate the stern of the central hull [14] with a minimized lateral distance between the pontoons [18], and a use position in which the first and second pontoons [18] are shifted fore relative to the storage position and have a maximized lateral distance between the pontoons [18].

SUMMARY OF CLAIMED INVENTION

A Second Embodiment of the present claimed invention (claims 12-24) is directed to personal watercraft having (i) a hull defining a deck with a planar upper surface, and (ii) a plurality of pontoons repositionably attached to the hull with at least one pontoon positioned off a starboard bow of the hull, at least one pontoon positioned off a starboard quarter of the hull, at least one pontoon positioned off a port bow of the hull, and at least one pontoon positioned off a port quarter of the hull. The pontoons are laterally and longitudinally repositionable as between a storage position having a minimized lateral and longitudinal distance between the pontoons to facilitate transportation and storage, and a flotation position having a maximized lateral and longitudinal distance between the pontoons to provide improved flotation stability relative to the storage position.

LEGAL BASIS

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found in the prior art, NOT in applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). *See,* M.P.E.P. § 2143.

RYPINSKI DOES NOT TEACH OR SUGGEST
ALL OF THE CLAIM LIMITATIONS
OF THE CLAIMED INVENTION

Rypinski discloses a modular watercraft system with a ***pair*** of repositionable side pontoons. In contrast, the Second Embodiment of the Present Claimed Invention is directed to personal watercraft with at least ***four*** repositionable side pontoons. Rypinski does not teach or suggest use of more than two repositionable side pontoons. Applicant has discovered that the use of four repositionable side pontoons, as opposed to just two, enhances the ability to adjust flotation stability to accommodate different situations.

7.0 The examiner has rejected claim 7 as obvious over Wassell (United States Patent 3,839,979) in view of Rypinski (United States Patent 5,582,126)

SUMMARY OF CITED REFERENCE

Wassell discloses a collapsible wind propelled vehicle. The relevant embodiment of the vehicle, represented by FIG 16, includes a central pontoon [20'], nominally referenced as a hull, with a first pontoon [10s] attached proximate the starboard side of the central pontoon [20'] and a second pontoon [10p] attached proximate the port side of the central pontoon [20']. The first and second pontoons [10s and 10p] are repositionably attached to the central pontoon [20'] for lateral and longitudinal repositioning of the first and second pontoons [10s and 10p] as between a

storage position in which the first and second pontoons [10s and 10p] are generally longitudinally aligned relative to the central pontoon [20'] and have a minimized lateral distance between the pontoons [10s and 10p], and a use position in which the first and second pontoons [10s and 10p] are shifted fore relative to the longitudinally aligned storage position and have a maximized lateral distance between the pontoons [10s and 10p]. Wassell discloses that the collapsible frame may support a deck, but is silent as to the nature of that deck (*e.g.*, rigid metal or flexible canvas) and is silent as to the location and/or means of attaching the decking onto the collapsible frame.

Rypinski discloses a modular watercraft system. The relevant embodiment of the system, represented by FIG 4, includes a central hull [14] with a first pontoon [18] attached proximate the starboard side of the central hull [14] and a second pontoon [18] attached proximate the port side of the central hull [14]. The first and second pontoons [18] are repositionably attached to the central hull [14] for lateral and longitudinal repositioning of the first and second pontoons [18] as between a storage position in which the first and second pontoons [18] are generally longitudinally positioned proximate the stern of the central hull [14] with a minimized lateral distance between the pontoons [18], and a use position in which the first and second pontoons [18] are shifted fore relative to the storage position and have a maximized lateral distance between the pontoons [18].

SUMMARY OF CLAIMED INVENTION

A First Embodiment of the present claimed invention (claims 1-11) is directed to personal watercraft having (i) a hull defining a deck with a planar upper surface, and (ii) a plurality of pontoons repositionably attached to the hull with at least one pontoon attached proximate the starboard side of the hull and at least one pontoon attached proximate the port side of the hull. The pontoons are laterally and longitudinally repositionable as between a storage position in which the pontoons are generally longitudinally aligned relative to the hull and have a minimized lateral distance between the pontoons, and a flotation position in which the pontoons are shifted aft relative to the longitudinally aligned storage position and have a maximized lateral distance between the pontoons.

LEGAL BASIS

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found in the prior art, NOT in applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). *See,* M.P.E.P. § 2143.

NEITHER WASSER NOR RYPINSKI
TEACH OR SUGGEST
ALL OF THE CLAIM LIMITATIONS
OF THE CLAIMED INVENTION

Wasser discloses a collapsible wind propelled vehicle wherein side pontoons can be shifted outward and ***forward*** from a longitudinally aligned storage position. Similarly, Rypinski discloses a modular watercraft system with side pontoons which can be shifted outward and ***forward*** from a storage position. In contrast, the First Embodiment of the Present Claimed Invention is directed to personal watercraft wherein side pontoons can be shifted outward and ***rearward*** from a longitudinally aligned storage position. Neither Wasser nor Rypinski disclose, teach or suggest such rearward repositioning. Applicant has discovered that such rearward repositioning is essential to achieving proper flotation stability.

8.0 *The examiner has rejected claims 20 and 21 as obvious over Rypinski (United States Patent 5,582,126) in view of Wassell (United States Patent 3,839,979).*

SUMMARY OF CITED REFERENCE

Rypinski discloses a modular watercraft system. The relevant embodiment of the system, represented by FIG 4, includes a central hull [14] with a first pontoon [18] attached proximate the starboard side of the central hull [14] and a second pontoon [18] attached

proximate the port side of the central hull [14]. The first and second pontoons [18] are repositionably attached to the central hull [14] for lateral and longitudinal repositioning of the first and second pontoons [18] as between a storage position in which the first and second pontoons [18] are generally longitudinally positioned proximate the stern of the central hull [14] with a minimized lateral distance between the pontoons [18], and a use position in which the first and second pontoons [18] are shifted fore relative to the storage position and have a maximized lateral distance between the pontoons [18].

Wassell discloses a collapsible wind propelled vehicle. The relevant embodiment of the vehicle, represented by FIG 16, includes a central pontoon [20'], nominally referenced as a hull, with a first pontoon [10s] attached proximate the starboard side of the central pontoon [20'] and a second pontoon [10p] attached proximate the port side of the central pontoon [20']. The first and second pontoons [10s and 10p] are repositionably attached to the central pontoon [20'] for lateral and longitudinal repositioning of the first and second pontoons [10s and 10p] as between a storage position in which the first and second pontoons [10s and 10p] are generally longitudinally aligned relative to the central pontoon [20'] and have a minimized lateral distance between the pontoons [10s and 10p], and a use position in which the first and second pontoons [10s and 10p] are shifted fore relative to the longitudinally aligned storage position and have a maximized lateral distance between the pontoons [10s and 10p]. Wassell discloses that the collapsible frame may support a deck, but is silent as to the nature of that deck (*e.g.*, rigid metal or flexible canvas) and is silent as to the location and/or means of attaching the decking onto the collapsible frame.

A Second Embodiment of the present claimed invention (claims 12-24) is directed to personal watercraft having (i) a hull defining a deck with a planar upper surface, and (ii) a plurality of pontoons repositionably attached to the hull with at least one pontoon positioned off a starboard bow of the hull, at least one pontoon positioned off a starboard quarter of the hull, at least one pontoon positioned off a port bow of the hull, and at least one pontoon positioned off a port quarter of the hull. The pontoons are laterally and longitudinally repositionable as between a storage position having a minimized lateral and longitudinal distance between the pontoons to facilitate transportation and storage, and a flotation position having a maximized lateral and

longitudinal distance between the pontoons to provide improved flotation stability relative to the storage position.

LEGAL BASIS

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found in the prior art, NOT in applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). *See,* M.P.E.P. § 2143.

NEITHER RYPINSKI NOR WASSER
TEACH OR SUGGEST
ALL OF THE CLAIM LIMITATIONS
OF THE CLAIMED INVENTION

Rypinski discloses a modular watercraft system with a ***pair*** of repositionable side pontoons. Similarly, Wasser discloses a collapsible wind propelled vehicle with a ***pair*** of repositionable pontoons. In contrast, the Second Embodiment of the Present Claimed Invention is directed to personal watercraft with at least ***four*** repositionable side pontoons. Applicant has discovered that the use of four repositionable side pontoons, as opposed to just two, enhances the ability to adjust flotation stability to accommodate different situations.

9.0 *The examiner has rejected claims 27, 29 and 31 as obvious over Rudder (United States Patent 3,902,741) in view of Vanderlinde (United States Patent 5,547,209).*

SUMMARY OF CITED REFERENCE

Rudder discloses a wheel fitting for boats which includes (i) wheels pivotally attached proximate the stern of a boat [10] for pivoting between a lower towing position and an upper

flotation position, and (ii) first and second brackets [45] attached to each side of the boat proximate the bow for releasably receiving the radius bars [44] of a tow hitch. The fitting permits a boat [10] to be towed in an normal upright position.

Vanderlinde discloses a boat transport device which includes (i) a wheel [25] with a C-clamp for attachment to a boat [10] along the uppermost edge of the bow, and (ii) a pair of C-clamps [31] each bearing a journal bracket [30] for releasable attachment to a boat [10] along the uppermost edge of the stern. The device permits a boat [10] to be towed in an inverted position.

SUMMARY OF CLAIMED INVENTION

A Third Embodiment of the Present Claimed Invention (claims 26, 27 and 29-37) is directed to a personal watercraft having (i) a hull defining a deck with a planar upper surface, and (ii) a pair of laterally spaced hitch attachments secured to the hull below the planar upper surface proximate the stern. The aspect of the Third Embodiment encompassed by claims 27, 29 and 31 further include another pair of laterally spaced hitch attachments secured to the hull below the planar upper surface proximate the bow.

LEGAL BASIS

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found in the prior art, NOT in applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). *See,* M.P.E.P. § 2143.

THE RUDDER AND VANDERLINDE REFERENCES
DO NOT PROVIDE MOTIVATION TO COMBINE THE
TEACHINGS OF THE REFERENCES

In order to prevent a hindsight-based obviousness analysis, the relevant inquiry for

determining the scope and content of the prior art is whether there is a reason, suggestion, or motivation in the prior art or elsewhere that would have led one of ordinary skill in the art to combine the references. *See*, In re Rouffet, 149 F.3d 1350, 1359, 47 U.S.P.Q.2d 1453, 1459 (Fed. Cir. 1998) ("[T]he Board must identify specifically ... the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious."); In re Dembiczak, 175 F.3d 994, 999, 50 U.S.P.Q.2d at 1614, 1617 (Fed. Cir. 1999) ("Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.") Obviousness may not be established by merely showing that the separate elements of the invention existed in the prior art. There must be some teaching or suggestion in the prior art to combine the elements. Arkie Lures, Inc. v. Gene Larew Tackle, Inc., 119 F.3d 953, 43 U.S.P.Q.2d 1294, (Fed. Cir. 1997). While the references need not expressly teach that the disclosure contained therein should be combined with another, the showing of combinability must be "clear and particular." In re Dembiczak, 175 F.3d at 999, 50 U.S.P.Q.2d at 1617. S*ee also,* Motorola, Inc. v. Interdigital Tech. Corp., 121 F.3d 1461, 43 U.S.P.Q.2d 1481 (Fed. Cir. 1997).

Rudder discloses a wheel fitting for boats which includes (i) wheels pivotally attached proximate the stern of a boat, and (ii) first and second brackets attached to each side of the boat proximate the bow for releasably receiving the radius bars of a tow hitch. The fitting of Rudder permits a boat to be towed in an normal upright position. In contrast, Vanderlinde discloses a boat transport device which includes (i) a wheel with a C-clamp for attachment to a boat along the uppermost edge of the bow, and (ii) a pair of C-clamps each bearing a journal bracket for releasable attachment to a boat along the uppermost edge of the stern. The device of Vanderlinde is effective for towing watercraft in an inverted position. Neither Rudder nor Vanderlinde provide any motivation to selectively combine the brackets disclosed in Rudder with the journal brackets of Vanderlinde. In fact, a combination of these components would not achieve an operable system as the fitting disclosed in Rudder requires the boat to be towed in the normal upright position while the device disclosed in Vanderlinde requires the boat to be towed in an inverted position.

10.0 *The examiner has rejected claim 30 as obvious over Vanderlinde (United States Patent 5,547,209) in view of Rudder (United States Patent 3,902,741).*

SUMMARY OF CITED REFERENCE

Vanderlinde discloses a boat transport device which includes (i) a wheel [25] with a C-clamp for attachment to a boat [10] along the uppermost edge of the bow, and (ii) a pair of C-clamps [31] each bearing a journal bracket [30] for releasable attachment to a boat [10] along the uppermost edge of the stern. The device permits a boat [10] to be towed in an inverted position.

Rudder discloses a wheel fitting for boats which includes (i) wheels pivotally attached proximate the stern of a boat [10] for pivoting between a lower towing position and an upper flotation position, and (ii) first and second brackets [45] attached to each side of the boat proximate the bow for releasably receiving the radius bars [44] of a tow hitch. The fitting permits a boat [10] to be towed in an normal upright position.

SUMMARY OF CLAIMED INVENTION

A Third Embodiment of the Present Claimed Invention (claims 26, 27 and 29-37) is directed to a personal watercraft having (i) a hull defining a deck with a planar upper surface, and (ii) a pair of laterally spaced hitch attachments secured to the hull below the planar upper surface proximate the stern. The aspect of the Third Embodiment encompassed by claim 30 further includes a wheeled attachment with (a) at least one element configured and arranged for cooperatively releasably engaging at least one of the hitch attachments secured to the hull proximate the stern, and (b) at least one wheel configured and arranged on the wheeled attachment such that the wheel transversely extends below the bottom of the hull when the element on the wheeled attachment is engaged with at least one of the hitch attachments secured to the hull proximate the stern.

LEGAL BASIS

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found in the prior art, NOT in applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). *See,* M.P.E.P. § 2143.

THE VANDERLINDE AND RUDDER REFERENCES
DO NOT PROVIDE MOTIVATION TO COMBINE THE
TEACHINGS OF THE REFERENCES

In order to prevent a hindsight-based obviousness analysis, the relevant inquiry for determining the scope and content of the prior art is whether there is a reason, suggestion, or motivation in the prior art or elsewhere that would have led one of ordinary skill in the art to combine the references. *See,* In re Rouffet, 149 F.3d 1350, 1359, 47 U.S.P.Q.2d 1453, 1459 (Fed. Cir. 1998) ("[T]he Board must identify specifically ... the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious."); In re Dembiczak, 175 F.3d 994, 999, 50 U.S.P.Q.2d at 1614, 1617 (Fed. Cir. 1999) ("Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.") Obviousness may not be established by merely showing that the separate elements of the invention existed in the prior art. There must be some teaching or suggestion in the prior art to combine the elements. Arkie Lures, Inc. v. Gene Larew Tackle, Inc., 119 F.3d 953, 43 U.S.P.Q.2d 1294, (Fed. Cir. 1997). While the references need not expressly teach that the disclosure contained therein should be combined with another, the showing of combinability must be "clear and particular." In re Dembiczak, 175 F.3d at 999, 50 U.S.P.Q.2d at 1617. S*ee also,* Motorola, Inc. v. Interdigital Tech. Corp., 121 F.3d 1461, 43 U.S.P.Q.2d 1481 (Fed. Cir. 1997).

Rudder discloses a wheel fitting for boats which includes wheels pivotally attached proximate the stern of a boat. The wheel fitting of Rudder permits a boat to be towed in an normal upright position. In contrast, Vanderlinde discloses a boat transport device which includes a wheel with a C-clamp for releasable attachment to a boat along the uppermost edge of the bow. The wheel of Vanderlinde permits a boat to be towed in an inverted position. Neither Rudder nor Vanderlinde provide any motivation to selectively modify the wheel pivoting mechanism disclosed in Rudder with the releasable wheel attachment mechanism of Vanderlinde. In fact, a combination of these components would not achieve an operable system as the releasable wheel attachment means of Vanderlinde positions the wheel for towing of the boat in an inverted position while the tow hitch of Rudder requires the boat to be towed in the normal upright position.

CONCLUSION

Applicant respectfully submits that all pending claims (claims 1-15) are in condition for allowance.

Respectfully submitted,

Date 26 January 04 By _____

Michael S. Sherrill, #32,302
SHERRILL LAW OFFICES, PLLC
4756 Banning Avenue, Suite 212
White Bear Lake, Minnesota 55110-3205
(651) 426-2400